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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,747	10/11/2001	Maxie A. Durel-Crain	P01269US (98151.1P2)	9363

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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,747

Applicant(s)

DUREL-CRAIN

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12,23 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12,23 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The following is the status of the claims as of the rendering of the BPAI decision of 3-25-04: Claims 1-7, 13-19, 21, 24-25 and 27-29 had been cancelled. Claims 20 and 22 were cancelled due to the 3-25-04 Board decision and lack of appeal thereof and claims 8-12, 23 and 26 are pending. After review of the instant application and the copending '616 application, it is noted that the filing date of claims 8-12 is 4-3-99 whereas the filing date of the claims 23 and 26 is 10-11-01. Claims 8-12, 23 and 26 were previously indicated as allowable. However, prosecution of these claims is reopened in light of the discovery of the new prior art which has been applied as set forth infra.

Specification

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the accessory as claimed in claim 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

3. The use of the trademarks on page 5, line 13 and page 8, lines 3-4 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. It is noted that page 5, last line appears to be a word or words.

Claim Language Interpretation

5. Claims 8-12 are interpreted as not invoking 35 USC 112, sixth paragraph, since the claim recites sufficient structure for performing the specified function.

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Claim Rejections - 35 USC § 112

6. Claims 8-12 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, a tampon string having a free end is claimed yet it is also claimed that such is securable to an attachment which attachment has an accessory which provides a means for locating the free end and/or prevent the free end of the string from being retracted. However, how can the end be free if it is secured to the attachment and accessory which provides a means for locating the end and/or preventing the end from being retracted. It is suggested the terminology "free"(each instance) be deleted. This rejection also applies to similar language in claim 26.

Claim Rejections - 35 USC §102/103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 8-9 are rejected under 35 U.S.C. 102(e) as anticipated by, or, in the alternative, under 35 USC 103 as obvious over Nagamine JP '268.

The Nagamine reference teaches an apparatus including a tampon 2 having a tampon string 1A having a first end attached to the tampon and a second end distal from the tampon and an attachment comprising a tampon extension string 1b having an accessory 13 secured thereto,

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see Figures 1-3 and page 3, lines 14-16, sentence bridging pages 3-4, paragraph 7, paragraph 12, especially the sentence bridging pages 6-7 (i.e. the portion 1a is like conventional pull out strings and the portion added thereto to lengthen it is of a different material), and paragraph 16 of the translation. Claim 8 requires the attachment being securable to the free end of the tampon string. It is the Examiner's first position that since the tampon extension string 1b is secured to the tampon string 1a it is "securable" thereto. It is noted that it is not claimed when the attachment is secured. Claim 8 also recites the accessory as providing a means for locating the free end of the tampon string and/or for preventing the free end of the tampon string from being retracted into the vagina of the user of the tampon. The Nagamine reference at paragraphs 3, 6 and 16 explicitly teaches that the lengthening of the pull out string, i.e. portion 1b, prevents the string, i.e. 1a and 1b, from being lost and the leading end of the string, i.e. 1b, is attached to the underpants. Therefore the reference either explicitly teaches the function, capabilities and/or properties of the accessory or since the structure of Nagamine is the same as that claimed, there is sufficient factual basis for one to conclude that the functions, capabilities and properties of the claimed structure are also inherent in the Nagamine structure. Alternatively, i.e. the Examiner's second position, since the tampon string of Nagamine is formed from a portion 1a which is formed of cotton material and water proofed as in conventional products and a portion 1b which is formed from resin fibers, i.e. two completely different materials which form an integral structure, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the portions separate but securable to each other since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art, see *Nerwin v. Erlichman*, 168 USPQ 177, 179. As discussed supra, the Nagamine reference

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at paragraphs 3, 6 and 16 explicitly teaches that the lengthening of the pull out string, i.e. portion 1b, prevents the string, i.e. 1a and 1b, from being lost and the leading end of the string, i.e. 1b, is attached to the underpants. Therefore the reference either still explicitly teaches the function, capabilities and/or properties of the accessory or since the structure of Nagamine, i.e. lengthened tampon string formed of two portions of different materials, is still the same as that claimed, there is sufficient factual basis for one to conclude that the functions, capabilities and properties of the claimed structure are necessarily and inevitably present in the modified Nagamine structure.

With regard to claim 9, it is noted that the claim does not require the tape be secured around the entire end of the tampon string and that the tape 13 is attached to the portion 1b, i.e. attached to or around at least a portion of the end of the string.

Claim Rejections - 35 USC § 103

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagamine '268.

Claim 12 requires the same structure as set forth in claim 9 as well as a peel-off backing and a sticky surface. See discussion of claim 9 supra. The Nagamine reference explicitly discloses that the tape 13 is adhesive, i.e. includes a sticky surface, but does not disclose a peel-off backing. However it is well known to employ peel-off backings in combination with sticky surfaces in any environment of use to protect the sticky surface from degradation or to prevent premature adhesion to an undesired surface. Therefore, to employ a peel-off backing layer in combination with the adhesive tape of Nagamine would have been obvious to one of ordinary

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skill in the art in view of the recognition that such a feature would prevent degradation of the sticky surface and/or prevent premature adhesion to an undesired surface and the desire of Nagamine to adhere the tape 13 to a specific desired surface, i.e. the exterior surface of the underpants.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petrus et al '224.

The Petrus et al reference teaches a tampon 12 and a tampon cord 16, i.e. a string, attached to the tampon having a first end attached to the tampon and a second free end distal from the tampon. The tampon string has a width of 4 mm, see col. 7, lines 13-14 of Petrus. Applicant claims the width of the string being $\frac{1}{4}$ " to $\frac{3}{4}$ ", i.e. 6mm to 19 mm, which Petrus does not set forth. However, Petrus does disclose the desire of the cord to provide additional surface area in order to resist large shear forces. Furthermore, at page 6, lines 25-27 Applicant does not disclose any reason for the width range of $\frac{1}{8}$ " to $\frac{1}{2}$ ", i.e. 3.2mm-13mm, let alone the narrower claimed range. Therefore, it would be obvious to one having ordinary skill in the art at the time the invention was made to employ a cord having the width of $\frac{1}{4}$ " to $\frac{3}{4}$ ", i.e. 6 mm to 19mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, (i.e. the general conditions of the width range are $\frac{1}{8}$ " to $\frac{1}{2}$ ", i.e. 3.2-13mm and Petrus teaches a width of 4mm which is within such range) discovering the optimum or workable ranges involves only routine skill in the art, In re Aller, 105 USPQ 233. It is noted that such would also provide additional surface area which is desired by Petrus.

11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gale '708 or Jammes '989 in view of Petrus et al '224.

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The Gale '708 device teaches a tampon, a, b, c, a tampon string d and an accessory attached adjacent the end thereof. The Jammes '989 device teaches a tampon 1, a tampon string 2 and an accessory 3 attached adjacent the end of the string. Claim 26 further requires the string having a width of from 1/8" to 1/2", i.e. 3.2 mm to 13 mm, which Gale or Jammes does not teach. However it is noted again that page 6, lines 25-27 does not disclose the reason for such width. Furthermore the cords or strings of Gale or Jammes are used for extraction or withdrawal of the tampon. Petrus also teaches a tampon cord which is used for extraction or withdrawal which is configured to have a width of 4 mm. Therefore to substitute the extraction or withdrawal cord or string of Petrus for the extraction or withdrawal cord or string of Gale or Jammes would be obvious, see *In re Siebentritt*, 54 CCPA 1083 (two equivalents are interchangeable for their desired function, express suggestion of desirability of substitution is not needed to render such substitution obvious).

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 8 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,312,419. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the effective filing date of the application claims is the same as those of the '419 patent, the one way *In re Vogel* test applies, i.e. are the claims of the application obvious in view of the claims of the patent? The answer is yes. The apparatus of claims 8 and 9 is broader than the apparatus claimed in claims 1-9 of the patent. Furthermore, once applicant has received a patent for a species or a more specific embodiment, he/she is not entitled to a patent for the generic or broader invention. This is because the more specific anticipates the broader or in other words the patented claims anticipate the application claims. See *In re Goodman supra*.

14. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,312,419. See discussion in the preceding paragraph. Furthermore, the patent claims explicitly disclose a sticky surface, but do not disclose a peel-off backing. However it is well known to employ peel-off backings in combination with sticky surfaces in any environment of use to protect the sticky surface from degradation or to prevent premature adhesion to an undesired surface. Therefore, to employ a peel-off backing layer in combination with the sticky surface of the patent claims would have been obvious to one of ordinary skill in the art in view of the recognition that such a feature would prevent degradation of the sticky surface and/or prevent premature adhesion to an undesired surface and the desire of patent claims to apply the sticky surface to a specific desired surface.

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15. Claims 23 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,312,419 in view of Petrus et al '224. Since the effective filing date of the application claims is later than those of the '419 patent, the one way In re Vogel test applies, i.e. are the claims of the application obvious in view of the claims of the patent? The answer is yes. See discussion of claims 8 and 9 supra. Claim 26 further requires the string having a width of from 1/8" to 1/2", i.e. 3.2 mm to 13 mm, which the patent claims don't teach, i.e. the claim is narrower in one aspect than the patent claims. However it is noted again that page 6, lines 25-27 does not disclose the reason for such width. Furthermore the string of the patent claim is used for extraction or withdrawal of the tampon. Petrus also teaches a cord which is used for extraction or withdrawal which is configured to have a width of 4 mm. Therefore to substitute the extraction or withdrawal cord or string of Petrus for the extraction or withdrawal cord or string of Gale or Jammes would be obvious, see In re Siebentritt, 54 CCPA 1083(two equivalents are interchangeable for their desired function, express suggestion of desirability of substitution is not needed to render such substitution obvious). In claim 23, the width of the string is claimed as being further limited to a width of the range 1/4" to 3/4", i.e. 6mm to 19 mm, which neither Petrus or the patent claims set forth. However, Petrus does disclose the desire of the cord to provide additional surface area in order to resist large shear forces. Furthermore, at page 6, lines 25-27 Applicant does not disclose any reason for the width range of 1/8" to 1/2", i.e. 3.2mm-13mm, let alone the narrower claimed range. Therefore, it would be obvious to one having ordinary skill in the art at the time the invention was made to employ a cord having the width of 1/4" to 3/4", i.e. 6 mm to 19mm, since it has been held that where the general conditions of a claim are disclosed in

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the prior art, (i.e. the general conditions of the width range are $1/8$ " to $1/2$ ", i.e. 3.2-13mm and Petrus teaches a width of 4mm which is within such range) discovering the optimum or workable ranges involves only routine skill in the art, In re Aller, 105 USPQ 233. It is noted that such would also provide additional surface area which is desired by Petrus.

Allowable Subject Matter

16. Claims 10-11 recite subject matter which the prior art references of good date, alone or in any combination, do not teach. The structure set forth therein is disclosed as providing the function set forth on page 2, lines 23-24, 25-27 and 30 et seq, and page 4, lines 22-28.

Conclusion

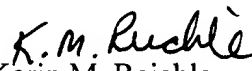
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The new prior art cited teaches various strings.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
December 7, 2004


JOHN E. KITTLE
DIRECTOR TC 3700